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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,090	12/06/2001	Ing Jan Turina	4456.004	5375

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EXAMINER

COMSTOCK, DAVID C

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/010,090	Applicant(s) TURINA, ING JAN	
	Examiner David Comstock	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003 and 20 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 24-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 24-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to because the changes made to Fig. 13 should be incorporated into formal drawings. The present drawings are acceptable for examination purposes. However, upon the allowance of any claims, new formal drawings will be required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 7, 8, 10, 11, 25, 26, 28, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Blazek (WO 99/02064; cited on PTO-1449).

Blazek discloses a process for making an elongate glass nail file comprising obtaining glass, chemically etching it to produce a rough surface 2, and hardening it. The glass is soaked in a substrate that facilitates ion exchange. The solution is hydrofluoric acid. Roughening the surface by chemicals permits a much smoother or fine surface roughness, i.e., a uniform rough surface devoid of sharp edges. Any portion of the device gripped by a user constitutes a handle. (See Fig. 1; page 1, lines 9-12, 16-18, and 22-23; page 2, lines 23-26; and page 3, lines 9-10.)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 5, 6, 16-21, 27, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blazek (WO 99/02064; cited on PTO-1449).

Blazek discloses the claimed invention except for hardening the glass by an undisclosed method instead of specifically by thermal treatment. Thermal treatment of glass, i.e., annealing or heating and cooling to increase strength, is merely one of several functionally equivalent, and well known, methods of hardening glass, known in the art. Therefore, because thermal treatment is merely one of many art-recognized methods of hardening glass, one of ordinary skill in the art would have found it obvious to substitute thermal treatment to harden the glass for any of several known hardening methods. With regard to claims 5 and 6 it likewise would have been obvious to etch the glass in a dissolved salt or potassium solution instead of hydrofluoric acid, as disclosed by Blazek, since these are merely functionally equivalent solutions for etching glass, known in the art. With regard to claims 16-21, providing the glass with indicia or a color would have been an obvious matter of design choice since doing so merely amounts to a modification of the appearance of the device. Moreover, such cosmetic changes are nothing more than any of numerous configurations a person of ordinary skill in the art would find obvious. *In re Dailey and Eilers*, 149 USPQ 47 (1966). With regard to claims

17-20, sand-blasting, engraving, imprinting, and grinding are all well-known and art-recognized equivalent methods of treating glass (for a general example in the art of glass processing, see Pyles (3,874,977)). Therefore, one of ordinary skill would have found it obvious to use any of these known and art-recognized methods to provide a desired aesthetic result.

Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blazek (WO 99/02064; cited on PTO-1449) in view of Haga (4,422,465).

Blazek discloses the claimed invention except for protecting a portion of the file prior to etching. Haga discloses protecting a portion of a metal file 10 with a film layer prior to etching to achieve a desired pattern on the file (see col. 4, lines 35-47). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the process of Blazek with a step of protecting a portion of the file prior to etching, in view of Haga, in order to achieve a desired pattern on the file.

Claims 13-15 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blazek (WO 99/02064; cited on PTO-1449) in view of Dulick (D284,225).

Blazek discloses the claimed invention except for the rigid sleeve extension and the removable sleeve that mates with the extension. Dulick shows a fingernail file having a sleeve extension and a removable sleeve mating therewith to protect and cover the file, obviously when not in use. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the file of Blazek with a sleeve extension and a removable sleeve mating therewith, in view of Dulick, in

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order to protect and cover the file when not in use. With regard to the rigidity of the sleeve, if it were not intended to be rigid, which it most likely would be, it nevertheless would have been obvious to form it from a rigid material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blazek (WO 99/02064; cited on PTO-1449) in view of Calafut (6,488,574).

Blazek discloses the claimed invention except for the step of forming a reflective surface on the file. Calafut discloses providing a file 10 with a mirror coating 30 to allow the user to perform two cosmetic functions utilizing one apparatus and improve the efficiency of the device (see Fig. 2; col. 2, lines 2-3; and col. 3, lines 48-49). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the file of Blazek with a reflective surface, i.e. a mirror coating, in view of Calafut, in order to allow the user to perform two cosmetic functions utilizing only one apparatus and improve the efficiency of the device. It would have been further obvious to use a reflective varnish for the reflective coating since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blazek (WO 99/02064; cited on PTO-1449) in view of Silverman (2,450,207).

Blazek discloses the claimed invention except for the handle comprising a smooth portion of the file substrate devoid of a grinding surface. Silverman discloses a file 2 comprising a handle 1 with a smooth portion devoid of a grinding surface to improve the comfort and convenience of the file (see fig. 6; col. 1, lines 9-10 and 47-49; and col. 2, lines 30-31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the file of Blazek with a smooth handle portion devoid of a grinding surface, in view of Silverman, in order to improve the comfort and convenience of the file.

Response to Arguments

Applicant's arguments filed 30 September and referenced in correspondence filed 20 August 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that Blazek (WO 99/02064) is not prior art because the applicant allegedly has a prior date of invention, it is noted the cited Blazek reference not only is prior art, but in addition, is a statutory bar to applicant's invention. The earliest effective filing date of applicant's invention is 06 December 2000 (due to the present application's dependence upon provisional application 60/251,727, filed 06 December 2000). However, the Blazek reference was *published* on 21 January 1999, which is, of course, more than one year before applicant's priority date. Therefore, Blazek indeed anticipates and renders obvious the claimed invention as set forth above

in the rejection. It is noted that the Blazek (WO 99/02064) reference was served upon applicant on 14 January 2003 by John J. Gresens of Merchant & Gould P.C. Additionally, a copy of the corresponding PTO-1449 was initialed and signed by the examiner and included in the action mailed 18 Mar 2003.

Applicant's remaining arguments pertaining to Blazek, Haga, Dulick, Calafut, and Silverman fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.



D. Comstock
06 December 2004



EDUARDO C. ROBERT
PRIMARY EXAMINER